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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,633	12/12/2001	Richard John Booth	5822-P1-01-CA	9641
28880	7590	01/23/2004	EXAMINER	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			MORRIS, PATRICIA L	
			ART UNIT	PAPER NUMBER

1625

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/021,633

Applicant(s)

BOOTH ET AL.

Examiner

Patricia L. Morris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-44 is/are pending in the application.
- 4a) Of the above claim(s) 3,8-11,13,17,18 and 21-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 12, 14-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1, 2, 4-6, 12, 14, 15, 16, 19 and 20 are under consideration in this application.

Claims 3, 8-11, ~~13~~, 17, 18 and 21-44 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b)

### ***Election/Restriction***

The restriction requirement is deemed sound and proper and is hereby made FINAL.

Again, this application has been examined with regard to the elected compounds wherein R<sup>1</sup> represents pyridyl and substituted pyridyl, R<sup>2</sup> represents phenyl and substituted phenyl, R<sup>3</sup> represents phenyl, substituted phenyl and biphenyl and n is 1-2, exclusively.

### ***Claim Rejections - 35 USC § 102***

The rejection under 35 USC 102 is hereby withdrawn in view of applicants' amendments to the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-7, 12, 14, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Daines, Wagner et al., Deyanov et al., Kester et al., Barchiesi et al., Moerkved, Shramm et al., Ferranti et al., Abramovitch et al I-VI, Peterson et al., and Aries for the reasons set forth in the record.

The instant compounds differ from the compounds claimed herein as alkyl homologs of the claimed compounds. Applicants have now changed  $n$  to one or two. However, the instant compounds wherein  $n$  is one are just the next adjacent homologs. It has been long established that this type of structural relationship- varying the size of a linking carbon chain – is per se obvious. Specifically, *In re Shetty*, 195 USPQ 753, *In re Wilder*, 195 USPQ 426 and *Ex parte Gresham*, 121 USPQ 422 all feature a compound with a  $C_2$  link rejected over a compound with a  $C_1$  link obvious.

Contra to applicants' arguments in the instant response, a compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness. The name used to designate the structural relationship between compounds is not controlling, it is the closeness of that relationship. Note *In re Payne et al.*, 203 USPQ 245.

Applicants also argue that the references do not suggest the disclosed utility of the claimed compounds. The recognition of a property of prior art compounds heretofore unappreciated is

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not a sufficient basis upon which to predicate the issuance of a patent, thereby withdrawing from the public domain that which is already therein. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977); In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970).

Applicants do not point to any objective evidence which demonstrates that the claimed compounds as a class exhibit any properties which are actually different from the closest prior compounds embraced by Muller et al. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977); In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 6, and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Again, the expression "substituted" is employed in claims 1, 5, 6 and 7 with no indication given as to what the substituents and protective groups really are.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

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Why? Because that claim precludes others from making, using, or selling that compound for 20 years.

Therefore, one must know what compound is being claimed.

The unknown substitution groups are not believed to meet the requirements of 35 USC 112, first paragraph.

These unknown substituents could easily alter the utility.

The written description is considered inadequate here in the specification. Conception of the intended substituents should not be the role of the reader. Applicants should, in return for a 20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 USC 112, first paragraph. If you (the public) find that it works, I claim it, is not a proper basis of patentability. In re Kirk, 153 USPQ 48, at page 53.

Contra to applicants' arguments in the instant response, one cannot tell from a simple reading of the claim what is being claimed. One must first conceive of the substituents. Then one must, by preparing the compound himself, determine if the substituents works or not. Where is the specific claiming and distinctly pointing out? How can applicants regard as their invention inexact concepts? The breadth of which they could not have possibly checked out with representative exemplification. The terms are not finite.

Applicants are claiming a compound of the formula. Pure chemistry, a compound. Not a resin of general property ranges, but a pure compound. That compound used for any purpose is taken from the public in a 20-year monopoly to applicants. Then, the public is entitled to know what compound they cannot use. Yet, the claim is not specific to that compound. The public

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cannot tell what they may not use. How is a claim of the instant breadth defensible in an infringement action?

As applied to pure compounds, *In re Cavallito and Gray*, 134 USPQ 370, and *In re Sus and Schaefer*, 134 USPQ 301, are considered to set the proper applicable standard of required definiteness and support.

Again, the claims measure the invention. *United Carbon Co. V. Binney & Smith Co.*, 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in *Lockheed Aircraft Corp. v. United States*, 193 USPQ 449, "Claims measure invention and resolution of invention must be based on what is claimed".

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": *In re Priest*, 199 USPQ 11, at 15.

### ***Priority***

Again, applicants are requested to update the status of the parent application, Ser. No. 09/422,568, on page 1 of the specification. The status needs to be added to the specification.

### ***Conclusion***

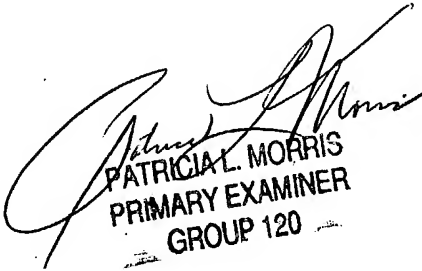
No claim is allowed.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

January 22, 2004